

REMARKS

Claims 38-44, which were previously renumbered per Rule 1.121 to claims 29-35 are pending. By this Amendment, claims 29 and 35 are amended.

Independent Claim 29 and dependent claim 35 have been amended to correct the informalities outlined in the Examiner's April 11, 2006 Office Action, namely, (1) a comma has been inserted between "Tyrosine" and "wherein" in line 5 of claim 29; (2) a period has been inserted at the end of claim 29; and (3) the word "divided" has been changed to "dividing" and the word "by" has been inserted between "dividing" and ".8929" in line 9 of claim 35.

The Examiner's April 11, 2006 Office Action also rejected claims 29-35 under 35 U.S.C. 112, first paragraph, on the basis that the phrase "for a patient not suffering from depression" in claim 29 is new matter and not supported by the specification and therefore violates the written description requirement of the first paragraph of 35 U.S.C. 112. Applicant respectfully traverses the Examiner's rejection for the following reasons stated herein, and respectfully requests the Examiner to withdraw this rejection.

A determination of whether the written description requirement is met is a question of fact. Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 996 (Fed. Cir. 2000) (citing In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976)). Courts have traditionally given great weight to the PTO's prior determination. See Monsanto Co. v. Mycogen Plant Science, Inc., 61 F. Supp. 2d 133, 190 (D. Del. 1999), *aff'd* 261 F.3d 1356, 59 USPQ2d 1930 (Fed. Cir. 2001) ("an especially weighty presumption of correctness applies when a PTO examiner allows a claim amendment without objecting to it as presenting new matter, or matter outside the description of the specification."); Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1574-75 (Fed. Cir. 1992) (" 'the fact that the Patent Office allows ... an amendment without objection thereto as new matter ... is entitled to an especially weighty presumption of correctness.' "); Chemcast Corp. v. Arco Industries Corp., 5 USPQ2d 1225, 1237

(E.D.Mich. 1987), *aff'd in part, rev'd in part, vacated in part & remanded*, 854 F.2d 1328 (Fed. Cir. 1988) (unpublished) (“the fact that the PTO allowed the amendment and did not consider the change as an addition of new matter is entitled to great weight.”).

Here, the PTO has already made the determination that the subject language meets the description requirement of the first paragraph of 35 U.S.C. 112. Specifically, prior to the 35 U.S.C. 112, first paragraph, rejection in the April 11, 2006 Office Action, the Examiner during the prosecution of U.S. Patent Application No. 09/412,701, which is now U.S. Patent No. 6,403,657, indicated in a July 18, 2001 Office Action that “Applicant may overcome the rejection by limiting the *patient to one not suffering from depression*.” [See attached Exhibit A, page 2 (emphasis added).]

Not only did the PTO subsequently issue the ‘657 patent after an amendment was entered containing the “for a patient not suffering from depression” language based upon the Examiner’s suggestion, but the PTO subsequently issued three additional related patents, which contained the same language in the claims. Specifically, the instant application is a continuation application of U.S. Patent No. 6,660,777, which is a divisional of the ‘657 patent, and U.S. Patent No. 6,384,088 and U.S. Patent No. 6,548,551 are divisionals of the ‘657 patent. All four of these issued patents (the ‘657 patent, the ‘777 patent, the ‘088 patent, and the ‘551 patent) contain claims directed toward a method “for a patient not suffering from depression.” Thus, in each of these cases, it is presumed that the Examiner(s) made a factual determination that the limitation currently under rejection was in fact supported by the same disclosure present in the instant application. Accordingly, the Examiner’s rejection is not only contrary to a prior examiner’s suggestion, which was relied upon by the Applicant, the fact that the PTO allowed the amendment and did not consider the change as an addition of new matter, and the PTO’s allowance of four patents containing the same language in their respective claims, but also to the great weight a court would give to such.

Notwithstanding the foregoing, the claims are supported by the specification. The very language cited by the Examiner: "Proper treatment of weight problems with the disclosed method is highly effective in resolving additional problems caused by or associated with obesity such as diabetes, hypertension, hypercholesterolemia, orthopedic problems, depression, anxiety, panic attacks, migraine headaches and other associated obesity related problems," (p. 7, lines 10-13), does not require a patient to be suffering from depression, or any other disease, condition, or problem, for the disclosed method to facilitate weight loss. The specification further states, "[s]till another principal object of the present invention is the provision of a comprehensive pharmacologic therapy for treatment of obesity which simultaneously treats other diseases or obesity related illnesses such as type II diabetes, hypertension, hypercholesterolemia, orthopedic problems, depression ... compulsive disorder, and/or myoclonus." [Application, p. 4, lines 15-20 (emphasis added).] The use of the word "or" as a conjunction specifically discloses the presence of one indication but not another in a patient. Thus a patient having, for example, hypertension would not necessarily have depression. Therefore, the specification reasonably conveys to one skilled in the relevant art that the Applicant, at the time of the application was filed, had possession of the claimed method to facilitate weight loss from a patient not suffering from depression.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian L. Stender", enclosed within a rectangular box.

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